

REMARKS

This application contains claims 1-417, the status of which is as follows:

(a) Claims 29, 39, 41, 45-46, and 54 are as originally filed.

(b) Claims 31, 37-38, 40, 57, 131-133, 136-140, 143-144, and 410-415 were previously presented.

(c) Claim 135 has been currently amended to correct a typographical error.

(d) Claims 416-417 are new.

(e) Claims 2, 4-8, 13-16, 18-25, 27-28, 30, 32-36, 42-44, 47-53, 55-56, 59-66, 77-78, 81-130, 141-142, and 145-406 were previously canceled. The Applicant may prosecute these claims in a continuation application.

(f) Claims 1, 3, 9-12, 17, 26, 58, 67-76, 79-80, and 407-409 have been currently canceled without prejudice. The Applicant intends to prosecute these apparatus claims in copending Application No. 10/258,714, as discussed hereinbelow.

(g) Claim 134 has been currently canceled without prejudice.

No new matter has been added.

Claims 1, 3, 9, 10-12, 17, 26, 29, 31, 37-41, 45-46, 54, and 57-58 were provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 5-30, 32, 33, 36-61, and 63-216 of copending Application No. 10/258,714. Claims 67-76, 79, 80, 131-140, 143, 144, and 407-

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415 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-30, 32, 33, 36-61, and 63-216 of copending Application No. 10/258,714 in view of US Patent 6,410,046 to Lerner.

While not necessarily agreeing with the nonstatutory obviousness-type double patenting rejection, in order to expedite the issuance of a patent on the claims believed to be allowable, the Applicant has:

(a) canceled all of the pending apparatus claims in the present application (claims 1, 3, 9-12, 17, 26, 58, 67-76, 79-80, and 407-409). As mentioned above, the Applicant intends to prosecute these apparatus claims in copending Application No. 10/258,714; and

(b) canceled all of the method claims in copending Application No. 10/258,714, in an amendment filed January 11, 2006.

The Applicant submits that the cancellation of these claims renders the statutory double patenting rejection moot. Although the Applicant also believes that the cancellation of these claims renders the nonstatutory double patenting rejection moot, the Applicant is filing a terminal disclaimer in the present application in order to expedite the issuance of a patent on the claims believed to be allowable.

Claims 1, 3, 9-12, 17, 26, 58, 67-76, 79, 80, and 407-409 (all of the apparatus claims of the present application) were rejected under 35 U.S.C. 103(a) as being

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unpatentable over US Patent 6,410,046 to Lerner. While disagreeing with the Examiner's grounds for rejection, in order to expedite the issuance of a patent on the claims believed to be allowable in the present application, the Applicant has canceled all of these apparatus claims. As mentioned above, the Applicant intends to prosecute these canceled apparatus claims in copending Application No. 10/258,714.

The double patenting rejections were the only grounds for rejection of the method claims (claims 29, 31, 37-41, 45-46, 54, 57, 131-133, 135-140, 143-144, and 410-415). As described above, these rejections have been rendered moot and/or overcome by the filing of the terminal disclaimer. The Applicant thus submits that method claims 29, 31, 37-41, 45-46, 54, 57, 131-133, 135-140, 143-144, and 410-415 are now in a condition for allowance.

Claims 43-44 were objected to because of the following informalities: claims 43 and 44 have not been formally cancelled. The Applicant hereby formally cancels these claims.

The status identifiers of claims 31, 37, 38, 40, and 57 have been corrected to read "previously presented" rather than "original," because these claims were amended in the parent application (Application No. 10/258,714) to remove multiple dependencies. The Applicant notes that the claim numbering in the present application is slightly different from that of the parent application, but respectfully suggests

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that renumbering the claims at this stage of prosecution would reduce rather than increase the clarity of the prosecution record.

The status identifiers of claims 131-133, 136-140, and 143-144 have been corrected to read "previously presented" rather than "original." These claims, as well as claim 135, were previously presented in a preliminary amendment dated May 13, 2004. These claims are supported in the specification as originally filed, as indicated in the following table (many of the claims find support in multiple locations in the specification in addition to those provided):

Claim	Support in specification
<p>131 ("to treat a condition of the patient")</p>	<p>"It is still a further object of some aspects of the present invention to provide improved methods and apparatus for remedying or modifying neurological activities and disorders via delivery of compounds through the blood-brain-barrier" (p. 4, lines 24-26).</p> <p>"These embodiments may be used in many medical applications. . . ." (page 5, lines 19-20).</p> <p>"In general, it is believed that substantially all pharmacological treatments aimed at cerebral cells for neurological and psychiatric disorders are amenable for use with these embodiments of the present invention" (p. 7, lines 21-24).</p>
<p>132 ("setting a parameter of the current")</p>	<p>"Microprocessor 32, in turn, preferably processes control signal 34 and feedback signal 36 so as to determine one or more parameters of the electric current to be applied through electrodes 24" (p. 16, lines 19-22).</p>

Claim	Support in specification
133 ("a frequency of the current")	"The configuration of couplers 26 and 28 and/or other circuitry in units 20 or 30 may determine the intensity, frequency, shape, monophasic or biphasic mode, or DC offset of the signal (e.g., a series of pulses) applied to designated tissue" (p. 16, lines 26-29).
135 ("setting the frequency to be greater than about 10 Hz")	". . . low frequencies cause secretion of NO, while high frequencies (e.g., above about 10 Hz) cause secretion of peptides (VIP)" (page 14, lines 27-28).
136 ("an amplitude of the current")	"The configuration of couplers 26 and 28 and/or other circuitry in units 20 or 30 may determine the intensity, frequency, shape, monophasic or biphasic mode, or DC offset of the signal (e.g., a series of pulses) applied to designated tissue" (p. 16, lines 26-29).

Claim	Support in specification
137 ("a waveform of the current")	<p>"For some applications, the waveform applied by one or more of electrodes 24 to designated tissue (e.g., the SPG) comprises a waveform with an exponential decay, a ramp up or down, a square wave, a sinusoid, a saw tooth, a DC component. . ."</p> <p>(page 17, line 9-11).</p>
<p>138 ("a shape of the waveform is selected from the list consisting of: an exponential decay, a ramp up or down, a square wave, a monophasic shape, a biphasic shape, a sinusoid, a saw tooth, and a DC component")</p>	<p>"For some applications, the waveform applied by one or more of electrodes 24 to designated tissue (e.g., the SPG) comprises a waveform with an exponential decay, a ramp up or down, a square wave, a sinusoid, a saw tooth, a DC component. . ."</p> <p>(page 17, line 9-11). "The configuration of couplers 26 and 28 and/or other circuitry in units 20 or 30 may determine the intensity, frequency, shape, monophasic or biphasic mode, or DC offset of the signal (e.g., a series of pulses) applied to designated tissue" (page 16, lines 26-29).</p>

Claim	Support in specification
139 ("one or more pulse bursts")	"The configuration of couplers 26 and 28 and/or other circuitry in units 20 or 30 may determine the intensity, frequency, shape, monophasic or biphasic mode, or DC offset of the signal (e.g., a series of pulses) applied to designated tissue" (page 16, lines 26-29).
140 ("a chemotherapeutic drug")	"Embodiments of the present invention have many medical applications. For example, chemotherapeutic drugs need to pass into cerebral tissue in order to treat brain tumors" (page 23, lines 16-18).
143 ("implanting a control unit at a site at a top of a bony palate")	"For some applications, stimulator 4 is implanted on top of the bony palate. . ." (page 13, line 17).
144 ("implanting a control unit at a site at a lower side of a bony palate")	"Alternatively or additionally, the stimulator is implanted at the lower side of the bony palate. . ." (page 13, lines 18-19).

Dependent method claims 416 and 417 are new. These claims respectively recite the two elements of the Markush group of claim 29, as originally filed. Because these new



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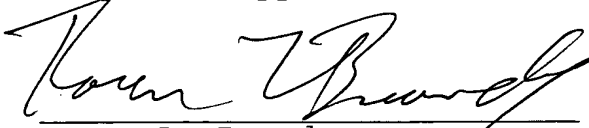
claims are of narrower scope than allowable claim 29 from which they depend, the Applicant submits that claims 416 and 417 are allowable.

The Applicant brings to the Examiner's attention copending Application Nos. 10/258,714 (filed January 22, 2003), 10/294,310 (filed November 14, 2002), 10/783,113 (filed February 20, 2004), 10/952,536 (filed September 27, 2004), 10/512,780 (filed June 1, 2005), 10/522,615, 10/518,322 (filed July 8, 2005), 10/535,024, and 10/535,025, and to co-assigned US Patent 6,853,858, issued February 8, 2005, which may be material to patentability of the present application.

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of objection and rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

Respectfully submitted,

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